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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,752	04/16/2003	Jay R. Akhave	310048-347-US	3930
24201	7590	12/28/2005	EXAMINER	
FULWIDER PATTON 6060 CENTER DRIVE 10TH FLOOR LOS ANGELES, CA 90045			DICUS, TAMRA	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/647,752

Applicant(s)

AKHAVE ET AL.

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-41 is/are pending in the application.
- 4a) Of the above claim(s) 35 and 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Acknowledgement is made of the cancellation of claims 1-14.

#### ***Election/Restrictions***

Newly submitted claims 35-36 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims are directed to a method including forming an individual droplet and repeating placement steps not in the originally presented article claims. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 35-36 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### ***Claim Objections***

Claims 20 and 22 are objected to as the language {"wherein the X is selected from"} is not an acceptable Markush group listing. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925). Suitable language to include would be {"wherein the X are selected from the group consisting of".

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 22, 29, 30-31, 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner believes that claims 22, 29, 30-31 and 34 (new) do not have the proper support in the original specification as filed because the specification does not provide any teaching or discussion on a casting sheet from which the label is subsequently delaminated, or fluid that is permeable in one dimension but impermeable in other dimensions, or layers including connected voids, or of electrically conductive and unconductivity in dimensions, or a release layer having voids, or its usage with Applicant's claimed laminate.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 15-34, 20, 21, 23-24, 39-40, and 41, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 20 recites the limitation "the first and second controlled droplet-formed layers", in order to make the claims consistent, claim 1 should state a first and second layer as there are other layers. There is insufficient antecedent basis for this limitation in the claim. Further it is not clear how both the layers comprise the additional layers as the overall structure is unclear.

6. Claims 21 and 23-24 comprise layers, but no structured order of them, thus the overall structure is unclear. Further claim 21 is unclear because reciting "the structure is an adhesive

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label having [a] facestock”, does not identify which parts of claim 15 is the adhesive layer and the facestock.

7. Claim 41 recites the limitation “said label is one label on a matrix-free label sheet of droplet-formed labels”, while Applicant is its own lexicographer, the term “matrix-free label” is not defined in the specification to understand what this means. Further to state a label is a label on a sheet of labels is not explicitly clear as to the overall structure.

8. Claims 15-34 and 39-41 recite the limitation “the laminate”. There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 15-22, 28, 30, 33, and 37-38 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,795,636 to Keller et al.

Keller shows PSA labels comprising a substrate 12, and at least two discontinuous controlled adhesive droplets, caps, and particle layers atop another layer 11, 14 forming at least one built-up layer, each layer having an array of controllably-placed material volumes having thickness and magnitude differences (see height extending laterally in the direction 18 down

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toward top surface of 12 including several discontinuous layers (at a selected location overlays and does not overlay-claim 19) (FIG. 1 and associated text) of adhesive droplets of film plasticizers or resins (col. 7, line 62-68) (where the closest layer closest to the top surface of 12 is functionally equivalent to a facestock because Applicant uses the same plasticizer material as a facestock on page 23, lines 23-25)). The adhesive is of different materials such as two or more adhesive materials or blends in discontinuous patterns of microsphere and latex adhesive for and including release liners. See col. 4, lines 34-60, col. 7, line 62-col. 8, line 14, col. 10, lines 50-60. The substrate comprises a controlled droplet-formed layer because the substrate has the controlled droplet-formed layers deposited thereon in the same way as Applicant (e.g. facestock layer 54 comprising a single layer of droplets by deposited droplets on its surface as denoted on page 24, lines 1-10 of Applicant's specification). The PSA label further comprises films of resin (claim 28, polymeric film), a release layer 22, low adhesion backside, carrier, release liner (delaminated casting sheet-claim 22) and tape (plurality of layers). See col. 5, lines 1-12, col. 7, lines 60-65, col. 11, lines 25-68. Claims 15-22 and 37-38 are met.

Further to claim 22, that the product is to be labeled is intended use, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Further to claim 30, connected voids are shown between multiple spaces between 11, FIG. 3.

Further to claim 33, Keller teaches different colored backgrounds (col. 4, lines 55-58) and thus provide the tactile and/or aesthetic visual effect.

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Claims 15-20, 22, and 37-38 are rejected under 35 U.S.C. 102(e) as being anticipated by USPN 5,935,670 to Downs.

Downs shows PSA labels comprising a carrier substrate 14, and at least two discontinuous controlled adhesive droplets, atop another layer forming at least one built-up layer, each layer having an array of controllably-placed material volumes having thickness and magnitude differences (see 22, and 22' of FIG. 3 including several discontinuous layers (at a selected location overlays and does not overlay-claim 19) (FIG. 3 and associated text) of adhesive droplets (where the closest layer closest to the top surface of 12 is functionally equivalent to a facestock because Applicant uses the same plasticizer material as a facestock on page 23, lines 23-25)). Claims 15-20, 22, and 37-38 are met.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,795,636 to Keller et al.

Keller essentially teaches the claimed invention above.

Keller does not teach the thickness ranges as claimed (instant claim 26), however, it would have been obvious to one of ordinary skill in the art to produce a thickness as claimed since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. Thickness effects the strength.

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Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,935,670 to Downs et al.

Downs essentially teaches the claimed invention above.

Downs does not teach the thickness ranges as claimed (instant claim 26), however, it would have been obvious to one of ordinary skill in the art to produce a thickness as claimed since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. Thickness effects the strength.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,795,636 to Keller et al. or alternatively USPN 5,935,670 to Downs et al. in view of USPN 4,606,956 to Charbonneau et al.

Keller and Downs are relied upon above, but do not teach the inclusion of microencapsulated materials (claim 32). However Keller teaches the adhesive layer includes microspheres and any other additive known in the art.

Charbonneau teaches a PSA multilayered sheet having an adhesive layer including microencapsulated material within the adhesive in order to rupture and release the ingredients contained therein at a certain rate (col. 2, lines 20-36, col. 3, lines 25-35, col. 5, lines 1-20, col. 6, lines 1-68).

It would have been obvious to one having ordinary skill in the art to have modified the multilayered sheet of Keller or Downs to include microencapsulated material because Charbonneau teaches a PSA multilayered sheet having an adhesive layer including microencapsulated material within the adhesive in order to rupture and release the ingredients



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contained therein at a certain rate (col. 2, lines 20-36, col. 3, lines 25-35, col. 5, lines 1-20, col. 6, lines 1-68).

***Allowable Subject Matter***

10. Claims 23-25, 29, 31, 34, and 39-41 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1<sup>st</sup> and 2nd paragraphs, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

11. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

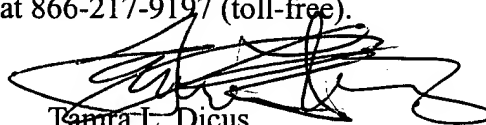
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus  
Examiner  
Art Unit 1774

December 16, 2005



RENA DYE  
SUPERVISORY PATENT EXAMINER

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